

REMARKS

Claims 1-20 are all the claims pending in the application. Claims 8-20 are added herein. Claim 4 stands objected. Claims 1-7 stand rejected on prior art grounds. The Applicant respectfully traverses these objections/rejections based on the following discussion.

I. The Objections to the Claims

Claim 4 stands objected to because the Office Action indicates that it is unclear what is being appended to the message. According to the specification (page 7, line 26), as originally filed, other messages may be appended to the message. Nonetheless, claim 4 is amended to delete the offending language. In view of the foreign, the Examiner is respectfully requested to reconsider and withdraw the objection to claim 4.

II. The Prior Art Rejections

Claims 1-7 stand rejected under 35 U.S.C. §102(a) as being anticipated by Fernandez, et al. (W.I.P.O. No. WO 99/65256), hereinafter referred to as Fernandez. Claims 1 and 4 stand rejected under 35 U.S.C. §102(a) as being anticipated by French-St. George (European Patent No. EP 0938213A2). The Applicant respectfully traverses these rejections based on the following discussion.

Fernandez discloses a system and method for delivering to a digital mobile phone notifications of e-mail or v-mail, or both of them, and for delivering e-mail summaries or v-mail summaries, or both of them, and which makes it possible for a user to configure all of his or her e-mail (and preferably also v-mail) account delivery options from a single location on the world-

09/919,730

8

wide web. The e-mail messages delivered to the phone are in a "summarized" form consistent with the message length limit and typically small display of a phone. The system does not interfere with existing e-mail or v-mail accounts but delivers to a user, via his or her digital phone, a notification that an e-mail (or v-mail) message is waiting for the user, along with some basic information (in the case of e-mail) about the message such as the identity of the sender, the time the message was sent, the subject and a truncated version of the main text. The user can retrieve the full message, with attachments, when access to an appropriate communications device is available. Alternatively, the user may call in to an interactive voice response server which is interfaced to the e-mail forwarding system, to obtain text-to-speech playback of e-mail messages. Optionally, the user may then dictate an immediate response to the IVR server which is then returned to the sender as a voice file attachment in a reply e-mail.

French-St. George discloses a system and method for providing multi-sensory signaling capabilities enabling a user to manage the receipt of incoming communication events, after an initial notification sequence, using multiple media options. Specifically, a remote device notifies a user of incoming communication events and offers real-time coupling of the notifications with communication management options. The message is delivered or otherwise processed according to the option selected.

However, amended independent claims 1, 6, and 7 include features not taught or suggested in the prior art references of record, and in particular, Fernandez and French-St. George. Specifically, amended independent claims 1, 6, and 7 generally recite, "wherein said predetermined actions comprise appending one message to another message." There is no teaching in Fernandez of incorporating such a feature in its system and method. Furthermore, as

generally provided in newly added dependent claims 8, 9, 12, 17, and 18, "the message ~~comprises~~ comprises a voice message, and converting said voice message into text; and transmitting said text in said notification to said user, wherein said predetermined actions comprise appending text from one voice message to text of another voice message." In contrast, Fernandez teaches text to voice conversion, but does not teach voice to text conversion because in Fernandez the goal is to send e-mails to a cellular phone, whereby the text of the e-mail is converted to voice so that the cell phone user can hear the contents of the e-mail. However, the claimed invention is not so limited, and provides for converting a voice message into text.

Additionally, page 5, paragraph 14 of the Office Action suggests that paragraph 105 of French-St. George teaches that "the predetermined actions include forwarding the message to one or more third parties." However, there is no teaching in paragraph 105 or any other paragraphs/drawings of French-St. George of the feature of "appending one message to another message" as provided in amended independent claims 1, 6, and 7. Thus, amended independent claims 1, 6, and 7 are patentable over French-St. George as well, and hence are patentable over the cited prior art references of record.

In view of the foregoing, the Applicant respectfully submits that the cited prior art references, namely Fernandez and French-St. George, do not teach or suggest the features defined by amended independent claims 1, 6, and 7 and as such, claims 1, 6, and 7 are patentable over Fernandez and French-St. George. Further, dependent claims 2-5 as well as newly added dependent claims 8-20 are similarly patentable over Fernandez and French-St. George, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicant respectfully requests

that these rejections be reconsidered and withdrawn.

Moreover, the Applicant notes that all claims are properly supported in the specification and accompanying drawings. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

III. Formal Matters and Conclusion

With respect to the objection to the claim 4, claim 4 has been amended, above, to overcome this objection. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the objection to claim 4.

In view of the foregoing, Applicants submit that claims 1-20, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary.

09/919,730

11

Best Available Copy

Please charge any deficiencies and credit any overpayments to Attorney's Deposit

Account Number 09-0441.

Respectfully submitted,

Dated: March 2, 2005



Mohammad S. Rahman, Esq.
Registration No. 43,029

McGinn & Gibb, PLLC
2568-A Riva Road, Suite 304
Annapolis, MD 21401
Voice: (301) 261-8625
Fax: (301) 261-8825
Customer Number: 29154

09/919,730

12

Best Available Copy